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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,145	05/23/2000	Paul Lapstun	NPA035US	9217
24011	7590	02/08/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/575,145	LAPSTUN ET AL.	
	Examiner	Art Unit	
	Thierry L Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>10/28/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

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### DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 10/6/04.
- Claims 1-18 are pending in application; Claims 19-44 have been canceled.
- An amendment filed to update an originally filed specification has been received and acknowledged.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 9-10, 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata et al (U.S. 6537324), and in view of Dymetman et al (U.S. 6330976).

Regarding claim 1, Tabata discloses a method for printing a digital photograph (i.e. medium form 201 of fig. 2 includes photographic image) including the following steps:

- transmitting (transmitting via a network, fig. 1) instruction for printing the photograph to a printer;
- printing the photograph (graphic icon, fig. 2) onto a surface using the printer (printer 40, fig. 1);
- also printing on the surface coded data (coded data 206, fig. 2, cols. 9-10) indicative of an identity of the photograph (coded data contains linkage information and document identifying information of the document and graphic icons, col. 6, lines 10-67) and at least one reference point on the surface.

However, Tabata fails to explicitly disclose an optical sensing device, when placed in an operation position relative to the surface, can generate indicating data using at least some of the coded data, the indicating data comprising data regarding the identity

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of the surface and data regarding a position of the sensing device relative to the surface, whereby a computer system can determine a photograph identity and/or an action relating to the photograph using at least some of the indicating data.

Dymetman, in the same field of endeavor for retrieving electronic data using coded data, teaches an optical sensing device (optical sensing pointer 502, fig. 1), when placed in an operation position relative to the surface (optical sensing pointer 502 for sensing coded data printed on the document, i.e. marking medium), can generate indicating data using at least some of the coded data (marking medium 2 of fig. 1 contains coded data and wherein an optical sensing pointer 502 is implemented for detecting location of the document and zones within the document's surface, figs. 3-7, col. 3, lines 39-67, col. 4, lines 24-35, col. 7, lines 42-67 and col. 8, lines 45-67), the indicating data comprising data regarding the identity of the surface and data regarding a position of the sensing device relative to the surface (optical sensor pointer 502 for detecting/sensing the marking medium's location/position/zones of the document's surface, col. 8, lines 40-67 to col. 9, lines 1-22, and col. 11, lines 28-45), whereby a computer system (optical sensor pointer 502 senses the coded data and transmits to a computer systems via a network 610, fig. 9, col. 8, lines 40-67 to col. 9, lines 1-22) can determine a photograph identity and/or an action relating to the photograph using at least some of the indicating data (i.e. retrieving a digital page of the printed document using an optical sensor pointer, and an optical sensor pointer for sensing the coded data printed on the document, figs. 1-2, cols. 7-9, and col. 11, lines 28-45 and figs. 13-15).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of Dymetman by implementing an optical sensing device for sensing the location/position/zones of the document's surface because of a following reason: (●) to accurately identify a specific location/position/zones of the document's surface (Dymetman, col. 8, lines 45-67); (●) to locate/obtain an copy of electronic copy of printed document via using coded data (sensing by optical sensing device) rather than manually retrieve by operators; by doing so, it increases the operating efficiency and reduces personnel costs (Dymetman, col. 18,

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lines 56-67 and other advantages can be found within the references, also see cols. 19-20 for additional advantage of using marking medium encoded with coded data).

Therefore, it would have been obvious to combine Tabata with Dymetman to obtain the invention as specified in claim 1.

Regarding claim 2, Tabata further discloses a method according to claim 1 wherein the identity of the photograph is determined by an identification code issued by a server (file server 20, fig. 1) which issues photograph identification codes (URL encoded data, fig. 2, cols. 13-14).

Regarding claim 3, Tabata further discloses a method according to claim 1 wherein a copy of the photograph may be requested by directing an optical sensing device towards a zone (code area 206, fig. 2) on the surface, which causes the optical sensing device to sense coded data on the surface and transmit a message to a printer (fig. 20, cols. 13-14), which in turns causes the printer to print a copy of the photograph (graphic dicon, col. 9, lines 25-30).

Regarding claim 4, Tabata further discloses a method according to claim 1 wherein a digital copy of the photograph is archived separately from the printed photograph and the original digital photograph (cols. 9-10).

Regarding claim 9, Tabata further discloses a method according to claim 1 wherein data indicative of an action is forwarded from an optical sensing device to a printer (fig. 20) when the optical sensing device is used to designate a particular zone of the surface.

Regarding claim 10, Tabata further discloses a method according to claim 1 wherein the surface has printed on it one or more options which a user may select, each associated with a designated zone on the surface, and the user selects an option by moving an optical sensing device on the surface within the associated zone (zone within

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the medium form, fig. 2), the optical sensing device transmitting data indicative of the user's selection to a printer (fig. 14-19).

Regarding claim 14, Tabata further discloses a method according to claim 1 wherein a user requests one or more other documents or photographs to be printed by directing an optional sensing device to a zone on the surface (optical scanner for scanning zones with in medium form, fig. 2).

Regarding claims 15-17, Dymetman teaches where the coded data is printed using an infrared ink and/or infrared-absorptive ink (cols. 11, lines 45-67 to col. 12, lines 1-25).

Regarding claim 18, the printer automatically binds the pages together are widely known in the art (i.e. copy machine with stapler options).

3. Claims 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Dymetman as described in claim 1 above, and in view of McIntyre et al (U.S. 6102505).

Regarding claim 5, Tabata and Dymetman teaches limitations (b) through (e) (see claim 1 above for more details), but does not teach a photograph is taking using a digital camera.

McIntyre, in the same field of endeavor for coded data, teaches a digital camera for taking digital photograph images (digital camera, fig. 1).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata as per teachings of McIntyre because of a following reason: (●) a digital camera which allows operator to take digital images and encrypted with barcodes.

Therefore, it would have been obvious to combine Tabata with McIntyre to obtain the invention as specified in claim 5.

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Regarding claims 6-7, the combinations of Tabata and McIntyre further teaches wherein the digital camera and printer form an integrated unit (fig. 1, col. 2, lines 55-67, McIntyre), the step of transmitting the digital photograph is done by means of a transmitter (network, fig. 1, Tabata) located in or proximate the integrated unit, the step of assigning an identification code is conducted on a computer (barcode is assign via file server and/or printer server, col. 6, lines 26-45) remote from the integrated unit, and the identification code is transmitted from the remote computer to the integrated unit before the digital photograph is printed (fig. 20, Tabata).

Regarding claim 8, the photograph identification code is also sent to a digital camera which took the photograph for future reference (image took by camera is also encrypted with barcodes, cols. 4, lines 50-67, McIntyre).

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tabata and Dymetman as described in claim 1 above, and in view of Wolff et al (U.S. 6081261).

Regarding claim 11, Tabata and Dymetman does not explicitly disclose wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movements of the optical sensing device being transmitted to a printer and converted to computer text.

Wolff, in the same field of endeavor for coded sensing device, teaches wherein a user annotates the photograph with text by writing with an optical sensing device on the surface, data indicative of the movements of the optical sensing device being transmitted to a printer and converted to computer text (fig. 6, abstract and cols. 4-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify Tabata and Dymetman as per teachings of Wolff because of a following reason: (●) provides a sensing instrument that is capable of sensing coded data and writing entries on documents/images.

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Therefore, it would have been obvious to combine Tabata and Dymetman with Wolff to obtain the invention as specified in claim 11.

Regarding claim 12, Wolff further discloses wherein a user signs the photograph by writing the user's signature on the surface with an optical sensing device, data indicative of the movement of the optical sensing device being transmitted to a printer, the signature thereafter being verified by comparison with a known signature of the user (signature verification, col. 2, lines 55-67).

Regarding claim 13, Wolff further discloses wherein a user draws on the photograph by drawing on the surface with an optical sensing device, data indicative of the movements of the optical sensing device being transmitted to the printer (abstract and cols. 6-7).

### ***Response to Arguments***

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection due to amended claims (newly added limitations). The newly added limitations as cited in claim 1: "such that an optical sensing device, when placed in an operative position relative to the surface, can generate indicating data using at least some of the coded data, the indicating data regarding the identity of the surface and data regarding a position of the sensing device relative to the surface, whereby a computer system can determine a photograph identity and/or an action relating to the photograph using at least some of the indicating data" overcome the cited prior art of record (US 6537324).

Regarding claims 1 & 5, the applicants argued the cited prior art of record fails to teach and/or suggest the newly added limitations as stated above.

In response, the examiner will note that Applicants are arguing subject matter not previously claimed in claims 1 & 5. Nowhere in previously claims 1 & 5 that applicants recite the nature of "such that an optical sensing device, when placed in an operative position relative to the surface, can generate indicating data using at least some of the



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coded data, the indicating data regarding the identity of the surface and data regarding a position of the sensing device relative to the surface, whereby a computer system can determine a photograph identity and/or an action relating to the photograph using at least some of the indicating data". A new ground of rejection is made in view of newly found prior art reference (U.S. 6330976).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

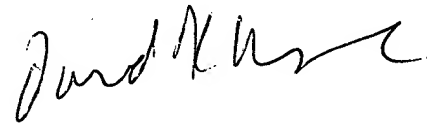
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L Pham whose telephone number is (703) 305-1897. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K Moore can be reached on (703)308-7452. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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